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REMARKS

Claims 30 and 31 has been withdrawn from consideration. Claims 1-29 remain before the Examiner for reconsideration.

In the office action, the Examiner required restriction to one of the following asserted inventions 35 U.S.C. Section 121:

- I Claims 1-29, drawn to process for producing N-vinyl formamide, classified in class 564 subclass 215.
- II Claims 30-31, drawn to a reagent comprising at least one cyclic anhydride group tethered to a solid support, classified in class 549, subclass 233.

Specifically, the Examiner asserted that:

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as crosslinking agent. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and being divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Henry Bartony on 10/26/04 a provisional election was made without traverse to prosecute the invention of Group, claims 1-29. Affirmation of this election must be made by applicant in replying to this Office action. Claims 30-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must

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be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants hereby affirm the election of claims 1-29 of Group I set forth by the Examiner.

The Examiner also rejected claims 1-29 under 35 U.S.C. 112 second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Specifically, the Examiner asserted that:

Claims are recited in terms of "including steps of..." and "including at least one cyclic anhydride..." and "including at least one diacid group." In doing so, claims are rendered indefinite, because it is not clear as to what are the things included and what are the things that are not included.

Applicants respectfully traverse the Examiner's rejection.

Claim 1, for example, sets forth a process to produce N-vinylformamide including the steps of:

- (i) reacting hydroxyethyl formamide with a reactant including at least one cyclic anhydride group to form an ester, and
- (ii) dissociating the ester to synthesize N-vinylformamide and a compound including at least one diacid group.

There is no ambiguity or indefiniteness in the language. Such language clearly sets forth to one skilled in the art the subject matter which applicant regards as the invention. As clearly set forth in the language of claim 1, the method includes or comprises a step (i) in which hydroxyethyl formamide is reacted with a reactant that includes at least one cyclic anhydride group. In the reaction of step (i), an ester is formed. The method further includes or comprises a step (ii) in which the ester (formed in step (i)) is dissociated to synthesize N-vinylformamide and a compound that includes at least one diacid group. In view of the unambiguous language of the claims, particularly in light of the description of the invention set forth in the specification of the present application,

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one skilled in the art would not be in doubt as to whether a particular method to produce N-vinylformamide is within the scope of the present claims. As set forth by the Federal Circuit in Personalized Media Communs., L.L.C. v. ITC, 161 F.3d 696, 705(1998)

Determining whether a claim is definite requires an analysis of whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more.

Applicants respectfully assert that under the appropriate standard, the present claims fully satisfy the requirements of the second paragraph of Section 112.

In view of the above, the Applicants respectfully requests that the Examiner, indicate the allowability of the Claims, and arrange for an official Notice of Allowance to be issued in due course.

Respectfully submitted,

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By 

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